

Docket No.: 3011-0002
File No. 1164.41428X00

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REMARKS

Claims 29-47 and 61-73 are pending in this application.

Claims 29, 61 and 72 are independent.

Claims 63 and 67 are amended in a non-narrowing manner, solely for clarification and not for purposes of patentability.

Claims 72 and 73 are amended in a non-narrowing manner to correct obvious editorial errors, not for purposes of patentability.

It should first be noted that it is not understood whether pending claim 47 is objected to or rejected. The Office Action Summary accompanying the most recent Official Action (Paper No. 29) indicates that all currently pending claims are rejected. However, the Examiner does not reject, or otherwise mention, claim 47 in the Official Action. In the previous Official Action (Paper No. 26) the Examiner indicated the allowability of claim 47 if rewritten in independent form. It is respectfully requested that the Examiner clarify the status of claim 47. To the extent that the claim 47 is now rejected, it is also respectfully requested that the Examiner provide a detailed basis for the rejection.

The Examiner objects to the specification as failing to provide proper antecedent basis for claimed subject matter. In particular, the Examiner points to claims 72 and 73 and argues, as best understood, that at least the first, second, and sixth means for storing are not disclosed in the specification. The objection is respectfully traversed.

Presumably related to this objection, claim 72 stands rejected under 35 USC §112, second paragraph, as indefinite. In particular, the Examiner argues that it is unclear what is the corresponding structure to the "...means for storing the first product...". The rejection is respectfully traversed.

Each means recited in claims 72 and 73 is clearly supported in the specification. The Examiner's attention is courteously directed to Figures 1-4 and pages 3-10 of the present application for examples of means disclosed in the application for achieving the claimed functions. Regarding claim 72, an electronic commerce system includes a first server (e.g. a commerce application server (CAS) 16 at the top of Figure 1). This first server corresponds to the recited third means in claim 72. As also described on pages 7-8 with reference to Figure 2, the CAS communicates with a first network device (e.g. a

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set top box (STB) 16 at the top of Figure 1), receives a first product related request from the network device (e.g. the STB), further transmits the received first product related request, receives first product related data in response to the further transmitted first product related request, and transmits the received first product related data to the network device (e.g. the STB) in response to the received first product related request.

A second server (e.g. the head end database server (HEDS) 14 at the top of Figure 1) has a first database storing the first product related data and second product related data. This second server corresponds to the recited fourth means in claim 72, and this first database corresponds to the recited first means in claim 72. As also described on pages 8-9 with reference to Figure 3, the HEDS receives the further transmitted first product related request, transmits the stored first product related data to the first server from which that request is received, and still further transmits the received first product related request.

As also described on pages 9-10 with reference to Figure 4, a central server (e.g. the Commerce Control Point Server (CCPS) 20 that forms part of the commerce control point (CCP) 24) has a second database storing the first and the second product related data. This central server corresponds to the recited fifth means in claim 72, and this second database corresponds to the recited second means in claim 72. As described, the CCPS 20 transmits the first and second product related data stored in the second database (e.g. the CCPS 20 database), receives the still further transmitted first product related request, and stores the received request in the second database (e.g. the CCPS 20 database). The first and the second product related data stored in the first database (e.g. the HEDS 14 database) are the first and second product related data transmitted by the central server (e.g. the CCPS 20).

In regard to claim 73, a third server (e.g. another CAS 16 at the bottom of Figure 1) communicates with a second network device (e.g. another STB 18 at the bottom of Figure 1), receives a second product related request from the second network device (e.g. another STB 18), further transmits the received second product related request, receives the second product related data in response to the further transmitted second product related request, and transmits the received second product related data to the second network device (e.g. the other STB 18) in response to the received second

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product related request. This third server corresponds to the recited seventh means in claim 73.

A fourth server (e.g. the other HEDS 14 at the bottom of Figure 1) has a third database storing the first and the second product related data. The fourth server corresponds to the recited eighth means, and the third database corresponds to the recited sixth means. This other HEDS 14 receives the further transmitted second product related request, transmits the stored second product related data to the third server (e.g. other CAS 16) from which that request is received, and still further transmits the received second product related request. Additionally, the central server (e.g. the CCPS 20) receives the still further transmitted second product related request and stores that received request in the second database (e.g. the CCAS 20 database).

In view of the above, it is respectfully submitted that the specification does in fact include antecedent basis for the subject matter of claims 72 and 73, and it is respectfully requested that the Examiner reconsider and withdraw the objection to the specification. And as should also be clear from the above discussion, corresponding structure is clearly associated in the specification with all claimed functions in claim 72, as well as those in claim 73. Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph, rejection of claim 72.

In addition to claim 72, claims 32, 63-65, and 67 stand rejected under 35 U.S.C. §112, second paragraph as indefinite. These rejections are also respectfully traversed.

It should be first noted that the Examiner has rejected claims 64 and 65 under 35 U.S.C. §112, second paragraph, in an omnibus fashion and accordingly the rejection cannot reasonably be understood. The Examiner has failed to address with any specificity whatsoever why these claims have been rejected. Accordingly, this rejection is improper and it is respectfully requested that the Examiner withdraw the rejection. If the Examiner should choose not to withdraw the rejection, it is respectfully requested that he provide a detailed explanation as to why he believes claims 64 and 65 are indefinite.

As best understood, the Examiner is now rejecting claim 32 as indefinite because he construes the claim phrase "only if" as an optional clause. As previously argued in prior responses, which are expressly incorporated herein, "only if" is not an optional

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clause. Claim 32 expressly requires that the first product related request be receivable from the one network device and the first product related data be transmittable to the one network device **only if** the one network device is tuned to one of the multiple broadcast channels. Claim 32 is only directed to the situation when the one network device is tuned to one of the multiple broadcast channels.

The Examiner's is attempting to transform claim 32 into a claim directed to a situation when the one network device is **not** tuned to one of the multiple broadcast channels. This transformation is clearly improper, as the claim clearly and unambiguously recites "**only if** the one network device is turned to one of the multiple broadcast channels", there is no alternative language recited, yet alone even implied, in the claim regarding the one network device **not** being turned to one of the multiple broadcast channels.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph, rejection of claim 32.

Regarding the indefiniteness rejection of dependent claims 63 and 67, the Examiner argues that each does not include every limitation of the claim (claim 61) from which both depend. The Examiner's reliance upon MPEP §608.01(n)III (directed to a test for infringement) for his position is not understood. The Examiner seems to construe the recited one second server of claim 63 and the recited first database of claim 69 as excluding limitations associated with those components recited in claim 61. It is respectfully submitted that the Examiner has misconstrued these claims.

Neither of claims 63 and 67 excludes any limitation, functional, structural, or otherwise, from the claim from which each depends. That is, claim 63 includes all the limitations of claim 61, and claim 67 likewise includes all the limitations of claim 61. In particular, according to the plain and unambiguous language of claim 63, the one second server recited in claim 63 includes a high priority queue and a low priority queue, receives the transmitted first product related request, queues the received first product related request in one of the high and the low priority queues, further transmits the received first product related request, receives first product related data transmitted by the first server, and transmits the received first product related data to the one network device in response to the received first product related request. The further

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transmission of the first product related request is after a first time period after receipt of that request if the request is queued in the high priority queue, or after a second time period after receipt of that request if the request is queued in the low priority queue. Also, according to the plain and unambiguous language of claim 67, the first database stores first product related data, second product related data, and video programming schedule data.

However, notwithstanding the impropriety of the rejection, claims 63 and 67 have been amended to repeat certain limitations of claim 61 to avoid any possible need to further prosecute this issue.

Claims 29-37, 41, 42, 44-46, 61, 62, 66, and 69-73 stand rejected under 35 U.S.C. §102(b) as anticipated by, and also stand rejected under 37 U.S.C. §103(a) as obvious over, PowerTV Inc., White Paper entitled "Applications and Service Infrastructure" (hereinafter "PowerTV") in view of Mimura (U.S. Patent No. 6,557,031). Claims 38-40, which depend from claim 29, and claims 63-65, which depend from claim 61, stand rejected as obvious under 35 U.S.C. §103(a) over PowerTV/Mimura in view of Condon (U.S. Patent 5,956,714). Claim 43, which depends from claim 29, and claims 67 and 68, which depend from claim 61, stand rejected as obvious under 35 U.S.C. §103(a) over PowerTV/Mimura in view of Knudson (U.S. Patent 6,016,141). The rejections are respectfully traversed, and all previously submitted traversal arguments are incorporated herein by reference in their entirety.

In the latest Official Action the Examiner relies upon the previously unapplied Mimura reference for the teaching of "an easy to read diagram of the overall system" because the PowerTV reference "does not directly show a easy to read diagram of the complete system," and of duplicate servers and networks (Paper No. 29, page 6, lines 14-16, and page 9, lines 15-18). The Examiner's position is not entirely understood, as what a combination of PowerTV and Mimura would produce is not clear. Further, the Examiner has not provided compelling motivation for such a combination. Even if there were motivation to combine the two references, which it is respectfully submitted does not exist, and even if the two references could somehow be combined, such a combination would not produce the invention recited in the present claims, as certain features recited in the independent claims are neither taught nor suggested by

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PowerTV, as should be understood from prior traversal arguments and the prior supplemental appeal brief, or by PowerTV in combination with any of the references of record. By the Examiner's own admission, the Mimura reference is not applied to show any express limitations found in any of independent claims 29, 61, and 72. Rather, Mimura is applied to show duplicate servers. Additionally, what relevance the Examiner's arguments regarding new and/or unexpected results utilizing different number of servers vis-à-vis Mimura have is simply not understood.

Similarly, a combination of PowerTV, Mimura, and Condon, even if motivated, would not produce the inventions of claims 38-40 and claims 63-65, as should be clear from the discussion of Condon in the previous amendment. Also, a combination of PowerTV, Mimura, and the programming schedule data of Knudson, even if motivated, and even if possible, would not produce the inventions of claims 43, 67, and 67, as should be understood from the discussion herein.

Regarding claims 29-46, in the most recent Official Action the Examiner now acknowledges that not all limitations have been afforded patentable weight. The Examiner's stated reasoning for this lack of consideration is because of the recitation of functional limitations (Paper No. 29, page 12, line 20, through page 13, line 3, and page 14, lines 8-13). This explains the continued lack of a claim-by-claim analysis (let alone element-by-element analysis) of the present application in view of any prior art. As best understood, the Examiner argues that any functional claim language following an occurrence of "configured to" in the claims has been ignored, i.e., not considered while searching the prior art.

In support of his position the Examiner relies upon In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Lowery, 32 USPQ 2d 1031 (Fed. Cir. 1994), and Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc., 58 USPQ 2d 1508 (Fed. Cir. 2001). The Examiner's reliance upon these cases is not understood, for, while these cases do mention functional limitations, these cases certainly do not teach that functional limitations should not be given patentable weight. The Examiner's attention is courteously directed to In re Swinehart, 169 USPQ 226 (CCPA 1971), In re Dembiczak, 50 USPQ 2d 1614 (Fed. Cir., 1999), as well as MPEP § 2173.05(g), for discussion of a proper examination of claims including functional limitations. As is clear from

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Swinehart, Dembiczak, and the MPEP, functional limitations **must** be considered in determining patentability, just like any other express limitation. That is, a recited functional limitation must be searched for in the prior art, and if that functional limitation is not found in the prior art, the claim in which that functional limitation is recited is novel and unobvious.

According to the Examiner's own admission, functional limitations found in the present claims have not been given patentable weight. It is clear from the case law and from the United States Patent and Trademark Office's own examination guidelines that functional limitations should be given patentable weight. Thus the Examiner has not met his burden in examining the claims by ignoring recited functional limitations, i.e., not searching for and applying prior art disclosing the recited functional limitations. For this reason alone, the §102/§103 rejection of the present claims is improper and it is respectfully requested that the Examiner reconsider and withdraw the rejection.

Regarding claims 61-71, added by the previous amendment, these claims do not include the functional "configured to" language of claims 29-47. That is, claims 61-71 recite a system including components, i.e., a central server, a first server, etc, actually **performing** functions. However, the Examiner rejects these claims on the same grounds as claims 29-46 even though they do not include the "configured to" language to which the Examiner is contentious.

This rejection is simply not understood, especially in light of the Examiner's statement in the most recent Official Action that "[t]he Examiner admits that *if* Applicants actually claimed their computer performing the recited functions, the Representative's computer would not meet those limitations." Claims 61-71 expressly claim a system performing functions similar to those recited in claims 29-46. The examiner has not pointed to any prior art system containing components actually **performing** the limitations expressly mandated by claims 61-71. Rather, the Examiner has combined the rejection of these claims with the rejection of claims 29-46, in which the Examiner acknowledges that similar features to those in claims 61-71 have not been given patentable weight. As should be understood from the previous responses and appeal brief, the PowerTV system, even in combination with Mimura or any other reference, does not perform the functions required to be performed by claims 61-71. All one can

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assume is that the Examiner has chosen not to give patentable weight to limitations in claims 61-71 similar to functional limitations in claims 29-46.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the §102/§103 rejection of claims 61-71. If the Examiner chooses not to withdraw the rejection, it is further respectfully requested that the Examiner specifically point out where in the applied art each claimed limitation can be found.

Regarding claims 72 and 73, the Examiner combines the §102/§103 rejection of these mean-plus-function claims with the rejection of claims 29-46 and 60-71. Again, this rejection is not understood, as claims 72 and 73 include similar functional limitations to those in claims 29-46. The Examiner has acknowledged that the functional limitations of claims 29-46 not been given patentable weight. Thus, how the Examiner can reject claims 72 and 73 on the same grounds as claims 29-46 and 60-71 is not clear. The Examiner has not pointed to anything in the applied art disclosing or even suggesting the means for achieving the required functions of claims 72 and 73.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the §102/§103 rejection of claims 72 and 73.

In view of the foregoing, It is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136. is hereby made. Please charge any shortage in fees due in connection with the filing of

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this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

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